

Remarks

Applicants hereby add new claims 21-25 and cancel claim 16. Accordingly, claims 1-15 and 17-25 are pending in the present application.

Claims 1-3, 7-9, 11-12, 14-15, and 17 stand rejected under 35 USC 102(e) for anticipation over U.S. Patent No. 6,172,672 to Ramasubramanian et al. Claims 4-5, 10 and 18 stand rejected under 35 USC 103(a) for obviousness over Ramasubramanian et al. in view of U.S. Publication No. 2001/0037465 to Hart, III et al. Claims 6 and 16 stand rejected under 35 U.S.C §103(a) over Ramasubramanian et al. in view of Hart, III et al. and further in view of U.S. Patent No. 6,067,571 to Igarashi et al. Claim 13 stands rejected under 35 U.S.C §103(a) in view of Ramasubramanian et al. in view of Igarashi et al. Claim 19 stands rejected under 35 U.S.C §103(a) over Ramasubramanian et al. in view of U.S. patent No. 6,591,068 to Deitz et al. Claim 20 stands rejected under 35 U.S.C §103(a) over Ramasubramanian et al.

Applicants respectfully traverse the rejections and request allowance of all pending claims.

Applicants have amended the specification to add the serial number of the cited application. Withdrawal of the objection to the specification is requested.

Referring to claim 1, the Office Action identifies teachings of Ramasubramanian (abstract, col. 5, lines 21-44) as allegedly disclosing limitations of claim 1. It is stated on page 2 of the Action that the claimed photo-video acquisition device is viewed by the Examiner as *circuitry that gets the video and data information from video storage*. Referring to col. 3, line 50- col. 5, line 44, Ramasubramanian is clearly directed to a stored video system including a video server 102 for storing a video file 104 using storage device 124 and for delivering video content from the stored file 104 to a client.

Claim 1 recites the one or more photo-video acquisition devices ***individually comprise a camera***. Claim 1 further recites ***generating a video of a scene viewed by the camera***, and acquiring a high resolution photograph from the remote device using the ***video streamed from the one or more photo-video acquisition device*** comprising a camera. To the contrary, Ramasubramanian clearly relates to systems for ***storing already generated video content*** and delivering content of a file comprising already generated and stored video to a user. There is no teaching or

suggestion in the video server configuration of Ramasubramanian for generating a video or acquiring a high resolution photograph from a remote device using video streamed from one or more photo-video acquisition device comprising a camera as claimed. Limitations of claim 1 are not taught nor suggested by the prior art and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 4 recites enabling a user to control the one or more photo-video acquisition devices from the remote device. The photo-video acquisition devices are defined in claim 1 as comprising cameras. Ramasubramanian is directed towards delivery of content from already generated files and the disclosure of Ramasubramanian fails to teach or suggest any enabling of a user to control cameras from a remote device as claimed. Hart is referred to on page 6 of the action with respect to disclosing requesting of payment information for distributing title data as requested. Accordingly, even if Hart is combined with the teachings of Ramasubramanian, the combination of teachings fails to disclose or suggest limitations of claim 4 including enabling a user to control a camera from a remote device as claimed. Limitations of claim 4 are not taught nor suggested by the prior art and claim 4 is allowable.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed.).

As discussed above, limitations of claim 4 are not taught nor suggested by Ramasubramanian taken alone or in combination with the teachings of Hart and claim 4 is allowable. The prior art provides no control of a camera by a user from a remote device as claimed. Claim 4 is allowable for at least this additional reason.

Further, there is no motivation to modify the teachings of the prior art in an effort to arrive at Applicants' claim 4 invention. Any 103 rejection of claim 4 is improper without proper motivation as set forth in the MPEP. More specifically, Ramasubramanian is directed towards a system for storing files of video content and for delivering video content of the stored files. Hart is directed towards a system for delivering title data. There is no motivation to modify the reference teachings regarding a video server arrangement and a title data distribution system to arrive at Applicants' claim 4 invention. The only motivation may result from improper hindsight reliance upon Applicants' disclosure. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicants' invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). The 103 rejection of claim 4 is improper for this additional reason.

Further, Hart is nonanalogous subject matter and the rejection of claim 4 is improper for this additional reason. In particular, the combination of non-analogous art areas is precluded by long standing Federal Circuit precedent. Prior art references are only analogous if the reference is in the field of Applicants' endeavor or the reference is reasonably pertinent to the particular problem with which the inventor was concerned. MPEP §2141.01 (8th ed.) (citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Applicants are not concerned with title information or distribution of title information as claimed. Hart is not concerned with cameras or enabling a user of remote device to control a camera as defined in claim 4. Hart is nonanalogous subject matter and the 103 rejection of claim 4 is improper for this additional reason.

The rejection of claim 4 is improper for the above numerous reasons. Applicants request allowance of claim 4 in the next Action.

Claim 6 recites using a queue system to allow multiple users to control one or more photo-video acquisition devices. Referring to pages 8-9 of the Office Action, it is stated that Ramasubramanian does not teach nor suggest the claimed queue system. Thereafter, the Examiner relies upon the teachings of Igarashi to cure the deficiencies of Ramasubramanian. The reliance is misplaced.

As set forth above, a proper 103 rejection requires motivation to modify teachings of a reference or to combine teachings of plural references. Referring to page 9 of the Office Action, it is stated to it would have been obvious to enable the system of Ramasubramanian in view of Hart with video cameras along with video storage components in order to enable a user to view a live video. Applicants disagree.

The Federal Circuit (CAFC) discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. More specifically, the motivation "to enable a user to view live video" is a mere conclusion not based upon objective evidence of record as mandated by the Federal Circuit.

Additionally, Ramasubramanian is concerned with video storage and communicating video from storage to a user. Ramasubramanian is not concerned with live video or controlling cameras. The only motivation for combining the reference teachings of Igarashi with Ramasubramanian results from improper reliance upon Applicants' disclosure. Claim 6 is allowable for at least the above-numerous reasons.

Referring to claim 9, the Examiner on page 3 of the action states that because the images are used through a browser, it is inherent that the images are on a web page. Applicants disagree with the Examiner's reliance upon inherency in support of the rejection of claim 9.

The Examiner is reminded that, "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Col. 4, lines 7-11 of Ramasubramanian make clear that video decoder 108 of client 110 may be implemented as a web browser. Web browsers may be utilized to view files no matter where they are stored (e.g., including files resident upon client 110 itself as opposed to posted on a different server). Accordingly, a web browser may be utilized to interact with files stored locally, provided by a floppy disk, etc. and not posted on a web site. Accordingly, the mere fact that decoder 108 of client 110 may be a web browser fails to disclose, suggest or render inherent the claimed posting of a video and high resolution photograph on a web page inasmuch as a web browser may be used to interact with files regardless of where they are stored. Limitations of claim 9 are not shown nor suggested by the prior art, the reliance upon inherency is inappropriate, and claim 9 is allowable for at least this reason.

Independent claim 11 recites an apparatus comprising one or more photo-video acquisition devices capable of acquiring videos and high resolution photographs, and wherein the devices comprise remote video cameras as previously recited in claim 16. Claim 16 was rejected under 103 in view of Ramasubramanian, Hart and Igarashi. There is no motivation to combine the reference teachings of

Igarashi or Hart with Ramasubramanian as required by a proper 103 rejection and claim 11 is allowable.

Ramasubramanian is clearly directed to a stored video system. Ramasubramanian is not concerned with live video data transmission. The Office Action on page 10 merely states the combination is appropriate in order to enable a user to view a live video. The rationale is conclusory and is not based upon any objective evidence of record as mandated by the Federal Circuit. Ramasubramanian is only concerned with dissemination of stored video and is not concerned with arrangements using cameras. The only motivation results from improper reliance upon Applicants' disclosure as a road map as evidenced by the bald, cursory rationale provided in the Office Action. There is no motivation to combine the reference teachings and claim 11 is allowable for at least this reason.

The claims which depend from independent claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 17, the prior art of record fails to teach or suggest capturing video using one or more photo-video acquisition device comprising a camera in combination with the claimed logging, acquiring and receiving. Ramasubramanian is clearly directed to a stored video arrangement and is not concerned with capturing video using one or more camera. Further, there is no motivation to combine the teachings of Igarashi with the teachings of Ramasubramanian. Claim 17 is allowable for at least this reason.

The claims which depend from independent claim 17 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants hereby add new claims 21-25. The new claims are supported at least by Figs. 3A-5 and associated specification teachings of the originally-filed application.

Applicants request allowance of all pending claims.

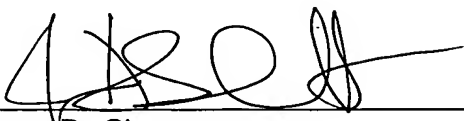
The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is

*Serial No. 10/023,951  
Case No. 10007843-1  
Amendment A*

available for telephone consultation at any time during normal business hours  
(Pacific Time Zone).

Respectfully submitted,  
Pere Obrador et al.

By

  
James D. Shaurette  
Reg. No. 39,833  
Date: 1/23/04  
(509) 624-4276